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10/665,714	09/19/2003	David Hendler Sloo	MS1-1652US	6005
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LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			WOODS, ERIC V	
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			2672	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,714

Applicant(s)

SLOO ET AL.

Examiner

Eric Woods

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is being sent *sua sponte* to correct a deficiency of the previous Office Action, where an argument concerning election by original presentation was incorrectly made.

Election/Restrictions

Claims 12-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1 September 2005 by canceling claims 11-62.

The restriction requirement issued in the previous Office Action was not traversed or even challenged and is thusly made **FINAL**.

Response to Arguments

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Therefore, the rejections of claims 1-11 under 35 USC 102(b) and 35 USC 103(a) are withdrawn since the claims have been substantially amended and their scope changed.

The rejection of claim 4 under 35 USC 112, second paragraph, stands withdrawn in view of applicant's amendments.

It is noted in response to applicant's arguments that whether or not the combination of Schein as modified by Klosterman's primary purpose is to cause the scaled image to be the same as that in the main window, the reference does show that

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as one embodiment that is possible (and expressly demonstrates it in the Figure). This essentially becomes a question of intended use.

In response to applicant's argument that the smaller window must show a scaled version of the main window, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the prior art does in fact show the system and method meeting the claimed limitation. Therefore, regardless of whether or not the system is capable of more than the claimed invention is irrelevant. It is settled that the system is at least capable of performing the recited claim, and that it has been used to this effect (Figure 5B). The BPAI has a strong track record of affirming examiners when there is clear evidence that the combination of references does in fact meet the required claim, whether or not that is its **primary** use.

Claim Objections

Claims 1 and 8 are objected to because the preamble does not recite 'computer-implemented'. The claims are not enabled without a computer (see the specification) and therefore this phrase must be added to the preamble in order to bring the claims in compliance with 35 USC 112, first paragraph, else a rejection against the claims will be included in the next Office Action.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al (US 6,323,911) in view of Klosterman et al (US PGPub 2005/0028201).

Claim 1 is a user interface and claim 8 is a method for operating a device for generating such a user interface.

As to claims 1 and 8,

A user interface comprising: (Preamble is not given patentable weight, since it only recites a summary of the claim and/or an intended use, and the process steps and/or apparatus components are capable of standing on their own; see *Rowe v. Dror*, 112 F.3d 473, 42 USPQ2d 1550 (Fed. Cir. 1997), *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999), and the like.)

-A full scale image presented for display, the full scale image being generated from a full scale video stream received from a content provider; (Schein teaches a system for

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displaying information on a television, which, as shown in Figs. 5B and 5C, particularly 5B, is capable of displaying a full-size image 132 on a display screen (10:30-10:65).

The images in Schein are television images transmitted from a content provider (4:10-55, 1:20-48, etc.).)

-A scaled image overlaid onto a portion of the full scale image for display, the scaled image being a scaled representation of the full scale image and generated from a compressed video stream received from the content provider, the compressed video stream being a compressed version of the full scale video stream; and (Schein shows a scaled version of image 132 shown as image 134, which is prima facie overlaid upon the larger, full scale image 132 in Figure 5B, which is shown therein. This is conclusive proof that the scaled image **can be** a scaled version of the full image. As is clearly stated, the "InfoMenu" window (e.g. element 130) shows a live version of whatever program is being examined in the menu, which if the current program were selected, it would thusly be showing it live, as recited in the claim. Further, Fig. 5B clearly shows that the scaled image 134 can be the same as that of the main display 132. Next, clearly any image in the box 134 that contains live TV is also being transmitted from a content provider, where the term only means 'a source of content' and is therefore a meaningless recitation.)(Klosterman teaches in [0057] that it is well known to transmit the PIP information (or that in the preview window) in a compressed format)

-A graphical user interface positioned next to the scaled image overlaid onto the full-scale image for display without obscuring the scaled image. (Schein clearly teaches a GUI, the "InfoMenu" window (e.g. element 130) shows a live version of whatever

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program is being examined in the menu, which if the current program was selected, it would thusly be showing it live, as recited in the claim. The InfoMenu window includes program listings 110 – showing the type of program shown in the preview window, as well as links to the program guide, and/or linked services, and finally this window can display the time and details of the duration of the program remaining, all of which are useful to the viewer to know and clearly constitute a 'graphical user interface'.)

Schein teaches almost all the limitations of the instant claim except the use of a compressed video stream for the browse window. However, Klosterman teaches that the use of such a stream uses less bandwidth [0041-0042] and is therefore inherently more efficient, and can also serve as a "tickler" to get the user to choose to tune into that programming (thusly increasing the effectiveness of the electronic program guide (EPG). Klosterman is an analogous art that is also an electronic program guide. Therefore, for at least the above reasons it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein to use a compressed video stream for the browsing or preview window as shown in Figures 5A-5C for the reasons stated in Klosterman and because it is well known in the art that transmitting a compressed video stream uses less bandwidth and is thusly more efficient.

Claims 2-4, 7, 9, and 11 are rejected under 35 U.S.C. 103(a) as unpatentable over Schein as modified by Klosterman as applied to claim 1 above, and further in view of Ichihara (US 5,455,632).

Reference Schein as modified by Klosterman teaches the all the limitations of the parent claim except the PIP window having a different format than that of the main image. Reference Ichihara clearly teaches in Figs. 3(a) and 3(b) the use of 'Squeeze mode' (e.g. normal mode') and 'Letterbox' mode (e.g. wide-screen for movies)(1:60-2:15). Further, Ichihara teaches in 2:20-2:50 that the sub-picture can have a 4:3 aspect ratio versus the main picture having a 16:9 aspect ratio. Figs. 4(a)-4(d) clearly reflect situations in which the format of the sub-picture is clearly tuned to be different than that of the main window, e.g. 4(c) wherein the main picture is operating in Normal mode and the PIP window is operating in Letterbox or Squeeze mode, with more details provided in Figs. 7(a)-7(d), where the trimming is applied by the circuit in Fig. 6 (6:3-7:25). Also, the system allows for the use of arbitrary aspect ratios (3:20-4:30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system of Schein as modified by Klosterman with that of Ichihara wherein the system of Schein as modified by Klosterman allows more control over the aspect ratio of the displayed image so that the system of Schein as modified by Klosterman would display a more pleasant PIP with increased circularity when used on a television or display having 4:3 and/or 16:9 resolution (Ichihara 1:15-2:30 and 3:15-4:30), and further to allow the user to choose the desired format of the displayed image.

As to claim 3, Schein as modified by Klosterman does not teach this limitation expressly, whereas Ichihara teaches (2:45-3:50) the use of a selector circuit such that the user can select the display mode of the main picture and the sub-picture. Motivation and combination are taken from claim 2 above and incorporated by reference.

As to claim 4, Schein as modified by Klosterman clearly teaches (as taught in the rejection to claim 1 above) and as shown in Fig. 5B that the two images are similar, e.g. that they are the same thing in a different scale factor. Since only the primary reference is utilized, no separate motivation or combination is required and that from the rejection to the parent claim is herein incorporated by reference.

As to claim 7, Schein as modified by Klosterman clearly teaches that the user can have different menus on screen (e.g. Figs 4A-11C all show various menus that the user can select, that is, various versions of the graphical user interface, specifically see Figs. 5A-5C). In addition, this is trivially well known in the art, e.g. the remote control is used to select different functionality, see for example Figs. 1 and 2, with buttons for selecting various menu options, and further in 4:55-7:32. Since only the primary reference is utilized, no separate motivation or combination is required and that from the rejection to the parent claim is herein incorporated by reference.

As to claim 11, this is the same thing as claim 7 above, wherein the user provides instructions via the remote control shown in Fig. 1, where prima facie the system must receive the instructions from the user to modify the menu shown on the screen of the apparatus. Motivation is taken from the parent claim and herein incorporated by reference. Since only the primary reference is utilized, no separate motivation or combination is required and that from the rejection to the parent claim is herein incorporated by reference.

Claims 5-6 and 10 are rejected under 35 U.S.C. 103(a) as unpatentable over Schein as modified by Klosterman in view of Yu (US 2004/0117819 A1).

As to claims 5 and 10, Schein as modified by Klosterman teaches all the limitations except explicitly stating that the scaled picture is placed along a left side of the full screen, while Yu teaches that the sub-picture or PIP window can be placed in the lower left corner of the screen in [0075]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the PIP and scaling of Schein as modified by Klosterman with Yu because Yu allows the user to control the position of the PIP window so that the user may place it (e.g. the scaled video) in the preferred position so as to not obscure some desired part of the full image (location of placement of PIP window is a design choice or preference in any case), see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). Also, if the claim is directed towards picture-on-picture (POP) technology, wherein the pictures are displayed side-by-side on the screen, that is well known in the television art and has been for over a decade (see for example US 5,847,771 to Cloutier (1:12-2:60) and US 5,459,528 to Pettitt (1:15-40), et cetera). Therefore, that would be a simply obvious and trivial variant of the above, and it would obvious that the system of Yu could also perform that functionality, as the circuitry involved would be the same (see Cloutier (1:12-2:60)).

As to claim 6, Yu teaches in [0075] that the system controller 161 in Figs. 1 and 3 can control the position of the Sub Picture 2.2, and in [0082] it is disclosed that arrow keys can be used to make selections, which imply that the user could move the PIP window move. As such, the claim would be obvious over the prior art. Motivation and combination is taken from the parent claim.

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Claim 6 is rejected under 35 U.S.C. 103(a) as unpatentable over Schein as modified by Klosterman in view of Karaoguz et al (US 2004/0117823).

As to claim 6, reference Schein as modified by Klosterman does not explicitly teach that the PIP window can moved, whereas reference Karaoguz clearly teaches in [0050] that the user can position the PIP window wherever desired on the screen so as to achieve a more flexible viewing experience [0050], thusly providing motivation for combination with Schein as modified by Klosterman.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Woods whose telephone number is 571-272-7775.

The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on 571-272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eric Woods

February 22, 2006


ULKA CHAUHAN
SUPERVISORY PATENT EXAMINER